

REMARKS

Please reconsider the claims in the application in view of the remarks below. In the present application, Claims 1-22 remain pending. Claims 1, 4, 5, 11, 12, 13 and 19 are independent.

Specification

The Office Action objected to the abstract of the disclosure allegedly because the phrase in the second sentence, "manipulates a character string includes append instruction ...", is grammatically incorrect. Reading the abstract as originally filed, applicant cannot find that phrase in the second sentence of the abstract. Rather, the abstract in the first sentence recites, "Compiler device for optimizing program which manipulates a character string includes append instruction detection unit, store code generation unit, and append code generation unit." That sentence is believed to be grammatically correct. Accordingly, applicant is not amending the abstract as suggested in the Office Action.

Disclosure on page 2 line 16 and page 4 line 16 were objected to because of a grammatical and spelling error. Those passages of the specification are being amended to correct the errors.

Claim Objections

Claim 14 was objected to because of the extraneous word "any." Claim 14 is being amended to delete that word as suggested by the Office Action.

Claim Rejections – 35 U.S.C. §101

The Office Action rejected claims 1-15 and 17-22 under 35 U.S.C. §101. In this reply, without conceding to the propriety of the rejection and in order to further advance the prosecution of the application, claims 2-10 are being amended to recite a “processor.” Applicant believes that those claims recite statutory subject matter under 35 U.S.C. §101.

Claim 19 is being amended to further recite, “A computer-implemented method” and “the append code being an optimized set of instructions for a processor to execute.” It is believed that claim 19 and its dependent claim 20 as amended have a real world practical application producing a practical result, “an optimized set of instructions for a processor to execute.” Accordingly, the Examiner is respectfully requested to withdraw the section 101 rejections of those claims.

Claims 11-18 and 21-22 being canceled. New claims 23-24 are being added. Support for the claim amendments can be found at least in Fig. 13 and the related description in the specification as originally filed.

Claim Rejections – 35 U.S.C. §112, first paragraph

The Office Action rejected Claims 1-15 and 17-22 under 35 U.S.C. §112, first paragraph, allegedly because it lacks utility. Applicant disagrees. A processor or processing device, a method and storage device for optimizing a program expresses utility on its face, that is, the utility of optimizing a program being executed by a processor and thus improving the processing time and resources of a processor. Accordingly, applicant respectfully requests that this rejection under section 112, first paragraph be withdrawn.

Claims 5-10 were further rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Particularly, those claims are rejected allegedly as being not enabling to one skilled in the art to which it pertains due to the level of abstraction in claims 5 and 9. It appears that the Office Action is objecting to the readability. Accordingly, the portions of claim 5 and 9 are being amended to improve its readability. Detailed explanation of the embodiments relating to claims 5-10 appears in Figs. 6-12 and the accompanying description in the specification as originally submitted. Accordingly, applicant respectfully requests that this rejection under section 112, first paragraph also be withdrawn.

Claim Rejection under 35 U.S.C. §102(e)

Claims 1 and 3 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,523,168 (“Arnold”). Without conceding to the propriety of the rejections, claims 1 and 3 are being canceled, claim 2 is being rewritten in independent form to recite elements of its base claim 1.

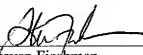
Claim Rejection under 35 U.S.C. §103(a)

The Office Action rejected claims 2 and 4-22 under 35 U.S.C. §103(a) as allegedly being unpatentable over Arnold in view of U.S. Patent Publication No. 2003/0145312A1 (“Bates”). Bates is not proper prior art for at least the reason of 35 U.S.C. §103(c). That section states, in part, “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person ...”. Bates was published on July 31,

2003, after the earliest filing date of the instant application. Therefore, the section under which it would qualify as a reference (which the applicant does not concede that it would) is subsection (e) of section 102. However, like the present application, Bates is assigned to International Business Machines Corporation. Accordingly, under 35 U.S.C. §103(c), citing Bates to preclude patentability of the claims under section 103 is not proper.

In view of the foregoing, this application is now believed to be in condition for allowance, and a Notice of Allowance is respectfully requested. If the Examiner believes a telephone conference might expedite prosecution of this case, applicant respectfully requests that the Examiner call applicant's attorney at (516) 742-4343.

Respectfully submitted,



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